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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,080	12/01/2003	Dragan Tomic	MSFT-2793/304866.01	4783

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WOODCOCK WASHBURN LLP (MICROSOFT CORPORATION)
CIRA CENTRE, 12TH FLOOR
2929 ARCH STREET
PHILADELPHIA, PA 19104-2891

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
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2161

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/06/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/726,080	Applicant(s) TOMIC ET AL.	
	Examiner Susan Y. Chen	Art Unit 2161	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8,10-12,20-25 and 27-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8,10-12,20-25 and 27-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

This office action is in response to the amendment filed on Jan. 23, 2007.

Claims 8, 10-12, 20-25 and 27-30 are pending for examination; claims 8, 10-12, 20-23, 25 and 27-30 have been amended.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As set forth in MPEP 2106 (II) (A):

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." State Street, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (Brenner v. Manson, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); In re Ziegler, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See Arrhythmia, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the

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utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Claims 8, 10-12, 20-25 and 27-30, are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 8, although this claim being amended in form "a database system" for storing data, however, the recitation of this claim merely has some intended usage without having any physical hardware that actually executes the intended functions. In addition, this claim only stores XML instances when the claimed "XML" instant is validated, otherwise, the instant invention just hang-up without bearing any concrete, tangible and useful results. Moreover, the instant specification lacks of an "explicit and deliberate" definition for the claimed "a subsystem" which carries through to the claim and limits as recited by applicant, as such, it directs to non-statutory subject matter.

As to claim 20, this claim merely recites descriptive steps, namely, the claim appears to be producing a tangible result only when an XML instance is conformed to one of the dual XML schema namespace URLs, otherwise, the instant invention just hang-up there without bearing any concrete, tangible and useful results, as such, it directs to non-statutory subject matter.

As to claim 25, the claim seems reciting merely software functional modules in form of computer readable medium, namely, when an XML instance is not conformed to

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any of the schema represented by the container, the claimed steps just hang-up there without producing any tangible, concrete and useful result.

As to claims 10-12, 21-24 and 27-30, these claims have the same defects as their base claims, hence, are rejected for the same reason.

To expedite a complete examination of the instant application the claims rejected under 35 U.S.C. 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8 and 10-12, are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

37 CFR 1.75(d)(1) provides, in part, that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the

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description.” In the situation in which the written description only implicitly or inherently sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function, and the examiner concludes that one skilled in the art would recognize what structure, materials, or acts perform the function recited in a means- (or step-) plus-function, the examiner should either: (A) have the applicant clarify the record by amending the written description such that it expressly recites what structure, materials, or acts perform the function recited in the claim element; or (B) state on the record what structure, materials, or acts perform the function recited in the means- (or step-) plus-function limitation. Even if the disclosure implicitly sets forth the structure, materials, or acts corresponding to a means- (or step-) plus-function claim element in compliance with 35 U.S.C. 112, first and second paragraphs, the USPTO may still require the applicant to amend the specification pursuant to 37 CFR 1.75(d) and MPEP § 608.01(o) to explicitly state, with reference to the terms and phrases of the claim element, what structure, materials, or acts perform the function recited in the claim element. See 35 U.S.C. 112, sixth paragraph (“An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.” (emphasis added)); see also *B. Braun Medical*, 124 F.3d at 1424, 43 USPQ2d at 1900 (holding that “pursuant to this provision [35 U.S.C. 112, sixth paragraph], structure disclosed in the specification is corresponding’ structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim. This duty to link or associate structure to function is the quid pro quo for the convenience of employing 112, paragraph 6.”); *Medical Instrumentation and Diagnostic Corp. v. Elekta AB*, 344 F.3d 1205, 1218, 68 USPQ2d 1263, 1268 (Fed. Cir. 2003)(Although one of skill in the art would have been able to write a software program for digital to digital conversion, such software did not fall within the scope of “means for converting” images as claimed because nothing in the specification or prosecution history clearly linked or associated such software with

the function of converting images into a selected format.); Wolfensperger, 302 F.2d at 955, 133 USPQ at 542 (just because the disclosure provides support for a claim element does not mean that the USPTO cannot enforce its requirement that the terms and phrases used in the claims find clear support or antecedent basis in the written description).

As to claim 8, the claimed "a subsystem" is new, since the instant invention fails to explicitly state or deliberately defined the metes and bounds of the claimed "a subsystem" which carries through to the claim and limits as recited by applicant, hence, it is considered as new matter.

As to claims 10-12, these claims have the same defects as their base claims, hence, are rejected for the same reason.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 10-12, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 8, it is uncertain whether the claimed "a subsystem" is a piece of hardware or software or others, hence, it renders the claim as indefinite. For the purpose of expedite a complete examination of the instant application all of the claimed

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“a subsystem” are considered as software instructions executed by a computer to perform the recited functions.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, 10-12, 20-25 and 27-30, are rejected under 35 U.S.C. 102(e) as being anticipated by Murthy et al. (U.S. Publication No. 7,096,224, hereinafter referred as Murthy).

Claim 8:

Murthy discloses a database system for storing data comprising Extensible Markup Language (XML) instances, said database system [e.g., Abstract], comprising:

- a subsystem for generating a container for XML schema namespaces [e.g., col. 3 lines 51-62]; and
- a subsystem for associating at least two XML schema namespace universal resource identifiers (URIs) with said container [e.g., col. 10, section: Mapping XML

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schemas to Object types – a Detailed Example starting at col. 10, line 45 at seq., the use of table “Default mapping of XML simple types to SQL” at col.(s), 11-12];

a subsystem for storing an XML instance in a database column [e.g., col. 3, lines 54-57, col. 9, lines 55-67];

a subsystem for typing said database column with said container, wherein said database system allows said XML instances to be stored in the database column only if said XML instance is validated according to an XML schema namespace identified by one of said at least two XML schema namespace URIs [e.g., XML Schema Validation at col. 5, lines 55-67, col. 9, line 37- col. 10, line 39].

Claim 10:

Except the limitations recited in claim 8, Murthy further discloses that a subsystem further comprising an import function which modifies said container so that it refers to at least one schema component in an XML schema namespace other than XML schema namespaces identified by said at least two XML schema namespace URIs [e.g., the use of table “Default mapping of XML simple types to SQL” at col.(s), 11-12].

Claim 11:

Except the limitations recited in claim 8, Murthy further discloses a subsystem that comprises an include function which allows assembly of schema component for a single namespace from several schema documents [e.g. col. 4, lines 10 – 37, XML Schema Registration at col. 4, line 40 – col. 5, line 52].

Claim 12:

Except the limitations recited in claim 8, Murthy further discloses a subsystem that comprises an alter function which adds schema components to XML schema namespaces within said container [e.g., col. 4, lines 20-21].

As to claims 20-24, these claims recite the same features as claims 8, 10-12 with different wording, hence, are rejected for the same reason.

As to claims 25, 27-30, the claimed instructions and software means are deemed to be inherent by the functional steps as recited in claims 8-12 and 20-24, hence are rejected for the same reason.

Response to Arguments

Applicant's arguments with respect to claims 8, 10-12, 20-25 and 27-30 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Points of Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Y. Chen whose telephone number is 571-272-4016. The examiner can normally be reached on Monday - Friday from 7:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mofiz Apu can be reached on 571-272-4080. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Susan Y Chen
Examiner
Art Unit 2161

February 28, 2007

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